

## REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

The final Official Action of June 10, 2010, has been carefully reviewed, and in view of the above amendments and the following remarks, reconsideration and allowance of the pending claims are respectfully requested.

At the outset, the undersigned counsel for Applicants would like to express her gratitude to Examiner Flick for the courtesies extended during the interview conducted on July 27, 2010, and the follow-up thereafter on August 5, 2010. In the above Official Action claims 1-7 and 9-19 were rejected on the ground of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7,322,960. The Official Action appears to indicate that the person signing the terminal disclaimer was not an attorney or agent of record, and hence not authorized to sign the same. Counsel for Applicants pointed out to the Examiner that the attorney/agent signing the Terminal Disclaimer submitted on March 4, 2010, was designated as an attorney of record authorized to act on behalf of the applicant in the original Declaration/Power of Attorney submitted on August 5, 2004. Accordingly, agreement was reached that the Terminal Disclaimer submitted March 4, 2010, is proper. On Page 10 of the Official Action, the Examiner notes the language "distal end portion" has been given the broadest reasonable interpretation and suggests claim amendments that would further limit this claim language. Upon further consideration and discussion with counsel, the Examiner indicated that no further amendments to this term is necessary. In addition, counsel proposed claim amendments to further distinguish over the cited prior art. The Examiner suggested

further amendments to clarify that the electrode is external to the insertion member. The Examiner indicated that such claim amendments appeared to distinguish over the applied interpretation of the prior art in the last Office Action. In view thereof, the claims have been amended as originally proposed, and to include the Examiner's suggestion clearly setting forth that the electrode is external to the insertion member.

In the above Office Action, claims 1, 6, 7, 9, 10 and 19 stand rejected under 35 USC 102(b) as being anticipated by Eggers et al. (U.S. Patent No. 6,106,524), claim 11 is rejected under 35 USC 103(a) as being unpatentable over Eggers et al., claims 2-5 are rejected under 35 USC 103(a) as being unpatentable over Eggers et al. in view of Shapland et al. (PCT Publication No. WO 99/04851), and claims 12-17 stand rejected as being obvious over Haim et al. (U.S. Patent No. 6,309,370) in view of Eggers et al. and Shapland et al. For at least the following reasons, Applicants respectfully traverse these rejections.

As set forth above independent claim 1 has been amended to recite, *inter alia*, "an electrode, separate and distinct from both said insertion member and said injection needle, said electrode being fixedly secured to an external surface of said distal end portion of said insertion member and spaced a predetermined distance from a bevel of said injection needle." Independent claims 12 and 15 have been similarly amended.

As initially set forth by the Examiner, "Eggers does not specifically disclose that an electrode is fixed at the distal end portion of the insertion member." (Official Action, page 4, last line - page 5, line 1). As now interpreted by the Examiner however, Eggers teaches "...a first electrode, separate and distinct from said injection needle, fixed at said distal end portion of said insertion member...".

Eggers discloses an energy applicator 60 including a tubular shaft 61 having a lumen 62, the distal edges 63 of which include a bevel 64 and the exposed region of which forms the distal electrode 65. A biopsy needle 130 is inserted through the lumen 62. The electrode 65 is separate and distinct from the needle 130, however, the electrode 65 is formed by the tubular shaft. Accordingly, Eggers fails to disclose "an electrode, separate and distinct from both said insertion member and said injection needle,..." as recited above in amended claim 1. Further, since the shaft 61 forms the electrode 65, it is not possible for the electrode to be fixedly secured to an external surface of the shaft as it can not be secured to an external surface of itself.

In rejecting claims 2-5, the Examiner further relies upon Shapland, but Shapland does not supply the teaching found to be lacking in the primary reference to Eggers. In Shapland, the needle 148 is formed with an electrically conductive material and functions as a delivery electrode (Page 7, lines 23-24), that is, "the needle 148 functions as a first electrode 160" (Page 8, lines 5-6). Thus, Shapland also fails to suggest an electrode "separate and distinct from both said insertion member and said injection needle," as recited in amended claim 1. Further, since the needle functions as the electrode in Shapland, it is not possible for the electrode to be "spaced a predetermined distance from ... said injection needle," as also recited in amended claim 1.

In contrast, the claimed invention has an electrode, separate and distinct from **both** said insertion member said injection needle, and fixedly secured to an external surface of said distal end portion of said insertion member and spaced a predetermined distance from a bevel of said injection needle.

In rejecting claims 12-17, the Examiner relies upon Haim et al. as the primary reference, in combination with Eggers. In contrast to independent Claims 12 and 15, the electrodes in Haim et al. are disposed on the distal end of the sheath 26. As recognized by the Examiner, Haim does not "specifically disclose the first electrode is fixed at the distal end portion of the insertion member" (Office Action Page 8, lines 11-13), and hence the Examiner also relies upon Eggers. However, as discussed above, Eggers discloses that the electrode 65 is formed by the tubular shaft 61 and thus it is not possible for the electrode to be fixedly secured to an external surface of the shaft as the electrode can not be secured to an external surface of itself. Thus, Eggers also fails to suggest the teaching found to be lacking in Haim.

For at least the reasons set forth above, Applicants submit that the prior art relied upon by the Examiner does not disclose or suggest an electrode separate and distinct from both said insertion member and said injection needle which is fixedly secured to an external surface of the distal end portion of the insertion member and spaced a predetermined distance from the bevel of the injection needle for measuring a cardiac action potential.

The dependent claims are allowable at least by virtue of their dependence from allowable independent claims. Thus, a detailed discussion of the additional distinguishing aspects recited in the dependent claims is not set forth at this time.

Early and favorable action concerning this application is respectfully requested. ***Applicants would greatly appreciate being contacted by the Examiner to discuss further possible amendments, if needed, to obtain allowance of the present application.***

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By: /WLWeinstein/  
Wendi L. Weinstein  
Registration No. 34456

**Customer No. 21839**  
703 836 6620